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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,791	04/20/2001	Rocco D'Antonio	1139	2557
7590	11/24/2003		EXAMINER	
ROBERT R. MALLINCKRODT MALLINCKRODT & MALLINCKRODT 10 EXCHANGE PLACE SUITE 510 SALT LAKE CITY, UT 84111			PASCUA, JES F	
			ART UNIT	PAPER NUMBER
			3727	20
DATE MAILED: 11/24/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/839,791	D'ANTONIO, ROCCO <i>CD</i>
	Examiner	Art Unit
	Jes F. Pascua	3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-7 and 10-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/03 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although the original specification discloses the plastic sack providing support and strength to the lighter weight paper sack to hold it together when filled with groceries. The specification, as originally filed, lacks antecedence for the paper container not being "strong enough to itself alone to hold groceries that would normally fit into the container". This is a new matter rejection.

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The functional recitation in the original specification that an object of the invention is to "not provide a stand alone paper sack intended to carry groceries on its own" does not provide antecedence for the now claimed paper container not being "strong enough to itself alone to hold groceries that would normally fit into the container".

4. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to provide an adequate written description of what is encompassed by the phrase "groceries that would normally fit into the container" so as to enable one skilled in the art to select a grade of paper.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 11 and 12 recite "a paper container made of a grade of paper of lighter weight than that used for standard paper grocery sacks whereby the paper container is not strong enough to itself alone hold groceries that would normally fit into the

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container". Since paper grocery sacks are made of different weights, it cannot be determined what weight or weights the claims require. It is apparent that one of ordinary skill in the art would recognize that there is some limit to the weight of paper included in these claims, but would not be able to determine, with any degree of certainty or precision, the particular limits of the weight recited in the claims so as to ascertain the metes and bounds of the claims. Addition of the phrase "groceries that would normally fit into the container" does nothing to limit the scope of the grade of paper in the claims since applicant has failed to specify what structure is encompassed by the phrase.

Furthermore, claims 2, 11 and 12 recite a paper liner whose base "perimeter is approximately equal to the base perimeter of the selected size plastic grocery sacks" and with "a height approximately equal to the height to the collar of the selected size plastic grocery sacks when said selected size plastic grocery sacks are opened and expanded." As similarly stated above, plastic sacks analogous to the ones used in grocery stores are made of different base perimeters and collar heights, therefore it cannot be determined what base perimeter and collar height dimensions are required by applicant's claims. Again, it is apparent that one of ordinary skill in the art would recognize that there is some limit to the base perimeter and collar height dimensions included in these claims, but would not be able to determine, with any degree of certainty or precision, the particular limits of the base perimeter and collar height recited in the claims so as to ascertain the metes and bounds of the claims.

Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Rodish or Fowler et al.

Applicant admits that using a paper grocery bag as a liner within a standard plastic grocery sack is old and well known. However, a paper bag whose base and height are “approximately equal” to that of an expanded “selected size plastic grocery bag” is not found. It would have been an obvious matter of design choice to make the admitted prior art paper liner with base and height dimensions that are approximately equal to a selected size plastic grocery bag (this includes those dimensions recited in claims 3-7, 10 and 14-18), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 7 and 13, the admitted prior art discloses the claimed invention, as discussed above, except for the grade of the paper bag being between 35 lbs. and 50 lbs.. Rodish teaches that it is known in the art to make grocery bags from

40 lb. paper and Fowler et al. teaches that it is known in the art to make barrel sacks from 25 lb. to 90 lb. paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the admitted prior art paper bag from the 40 lb. paper of Rodish or the 25 lb. to 90 lb. paper of Fowler et al. since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the phrase "whereby the paper container is not strong enough to itself alone hold groceries that would normally fit into the container", it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

9. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodish or Fowler et al.

Rodish and Fowler et al. each disclose the claimed invention except for the paper bags having a base and a height are "approximately equal" to that of an expanded "selected size plastic grocery bag". It would have been an obvious matter of design choice to make the paper bags of Rodish or Fowler et al. with base and height dimensions that are approximately equal to a selected size plastic grocery bag (this includes those dimensions recited in claims 3-7, 10 and 14-18), since such a modification would have involved a mere change in the size of a component. A change

in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding the phrase "whereby the paper container is not strong enough to itself alone hold groceries that would normally fit into the container", it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Regarding claim 11, Rodish and Fowler et al. disclose the claimed invention, as discussed above, except for the paper bags being placed within the selected size plastic grocery bag. It would have been an obvious matter of design choice to place the paper bags of Rodish or Fowler et al. within a selected size plastic grocery bag, since it appears that the inventions of Rodish and Fowler et al. would perform equally well within a selected size plastic grocery bag.

Response to Arguments

10. Applicant's arguments with respect to claims 2-7 and 10-18 have been considered but are moot in view of the new ground(s) of rejection.

11. The declaration by the inventor, filed on 11/17/03 has been considered, but is not persuasive since Rodish and Fowler et al. disclose the manufacture of paper bags of a grade of paper within applicant's claimed range of 35 lbs. to 50 lbs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP
November 19, 2003